

KIM et al. -- 09/604,086
Attorney Docket: 082118-0274477

REMARKS

Claims 1-11 are pending. By this Amendment, claims 1-4 and 7-8 are amended.

In the Office Action dated February 27, 2004, claims 1-11 were rejected under 35 U.S.C. §112, second paragraph. No prior art rejections were applied. In addition, a PTO-892 listing five references, four of which were previously submitted by Applicants, was included.

In response to the February 27, 2004 Office Action, Applicants submitted a response on July 27, 2004. In the response, claims 1-11 were amended to obviate the rejection under 35 U.S.C. §112, second paragraph.

In the January 6, 2005 Office Action, claims 1 and 4 were rejected under 35 U.S.C. §102(e) over Lai et al. (U.S. Patent 6,671,836) and claim 2 was rejected under 35 U.S.C. §103(a) over Lai et al. in view of Manning (U.S. Patent 6,032,274). The January 6, 2005 Office Action included a PTO-892 listing both references. The January 6, 2005 Office Action on page 7 states that Applicants' Amendment necessitated the new ground of rejection presented in the Office Action and that the Action was correspondingly made final.

The finality of the January 6, 2005 Office Action is improper and must be withdrawn. MPEP §706.07(a) states: "A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claims amended to include limitations which should reasonably have been expected to be claimed. See MPEP §904 *et seq.* For example, one would reasonably expect that a rejection under 35 U.S.C. §112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element." (Emphasis added.)

MPEP §2143.03 states: "A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the Examiner should reject the claim as indefinite under 35 U.S.C. §112, second paragraph (see MPEP §706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable." (Emphasis in original.)

It is clear from the MPEP sections discussed above that it is PTO policy that in the event claims are to be rejected under 35 U.S.C. §112, second paragraph, the Examiner should reject the claim under 35 U.S.C. §112, second paragraph and over any prior art that is applicable based on the Examiner's interpretation. It is also clear from the MPEP sections

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discussed above that a second or subsequent action on the merits may not be made final if it includes a rejection on prior art not of record of any claim that the Examiner should have reasonably expected to be amended to overcome a rejection under 35 U.S.C. §112, second paragraph. Neither Lai et al. nor Manning were of record from the February 27, 2004 Office Action. The new grounds of rejection based on Lai et al. and Manning thus were not necessitated by Applicants' Amendment and the finality of the Office Action is improper. As the finality of the January 6, 2005 Office Action is improper, Applicants are entitled to entry of this Amendment. See MPEP §706.07(e).

Withdrawal of the finality of the January 6, 2005 Office Action, entry of this Amendment and reconsideration based on the following remarks are respectfully requested.

Claims 1-3, 8 and 11 were objected to. Claims 1-3 and 8 have been amended in accordance with the suggestion of the Office Action. With respect to claim 11, it is respectfully noted that the phrase objected to by the Examiner does not appear in claim 11. Reconsideration and withdrawal of the objection to the claims are respectfully requested.

Claims 1 and 4 were rejected under 35 U.S.C. §102(e) over Lai et al. The rejection is respectfully traversed.

Claim 1 recites a method for compressing output data comprising writing a first data having a first number of bits into an address of a core cell region; reading the first data of the first number of bits written into the address as read data having the first number of bits; comparing the first data and the read data by dividing each of the first data and the read data into an upper portion having a second number of bits and a lower portion having a remaining number of bits; and generating a 1-bit compressed data for each of the upper portion and the lower portion with information indicating whether a failure is present.

The Office Action on page 4, paragraph number 10, alleges that Lai et al. disclose each and every feature of claim 1 in Figure 4A. However, it is respectfully submitted that Lai et al. do not disclose or suggest each and every feature of claim 1.

As discussed above, claim 1 recites comparing the first data and the read data by dividing each of the first data and the read data into an upper portion having a second number of bits and a lower portion having a remaining number of bits. Lai et al. disclose that the parallel read compare logic includes the OR gate 455 and XOR gates 465 and 495 for comparing write data to read data. Lai et al. do not disclose or suggest dividing each of the write data and the read data into upper and lower portions, as recited in claim 1.

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As Lai et al. do not disclose or suggest dividing each of the write data and the read data into upper and lower portions, it is also respectfully submitted that Lai et al. do not disclose or suggest generating 1-bit compressed data for each of the upper portion and the lower portion with information indicating whether a failure is present.

As Lai et al. do not disclose or suggest each and every feature of claim 1, it is respectfully submitted that Lai et al. do not present a *prima facie* case of anticipation.

Claim 4 recites a packet command driving type memory device comprising a read data comparing part capable of receiving a first data and a read data from a core cell region. Both the first data and the read data have a first number of bits. The read data comparing part is capable of comparing the first data with the read data and generating a compressed data having a second number of bits. A data input/output part is capable of transforming the compressed data and the read data to produce more than one data part and an interface part is capable of serially outputting the data parts from the data input/output part in a packet formed via an output pad.

It is respectfully submitted that Lai et al. do not disclose or suggest an interface part capable of serially outputting the data parts from the data input/output part in a packet form via an out pad, as recited in claim 4. The output shift registers 460 of Lai et al. outputs the data through a plurality of data pins, not serially as recited in claim 4.

As Lai et al. do not disclose or suggest each and every feature of claim 4, it is respectfully submitted that Lai et al. do not present a *prima facie* case of anticipation.

Reconsideration and withdrawal of the rejection of claims 1 and 4 over Lai et al. are respectfully requested.

Claim 2 was rejected under 35 U.S.C. §103(a) over Lai et al. in view of Manning. The rejection is respectfully traversed.

Claim 2 recites a method for comprising output data comprising, *inter alia*, comparing the first data and the read data by dividing each of the first data and the read data into an upper portion having a second number of bits and a lower portion having a remaining number of bits and compressing a result from the comparing to generate a compressed data with an information indicating whether a failure is present.

As discussed above, Lai et al. do not disclose or suggest, at least, this feature of claim 2. It is respectfully submitted that Manning fails to cure the deficiencies of Lai et al. with respect to claim 2. In particular, it is respectfully submitted that Manning also fails to disclose or suggest dividing each of the first data and the read data into an upper portion and

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a lower portion and compressing a result from the comparing to generate a compressed data with an information indicating whether a failure is present. Accordingly, even assuming it would have been obvious to combine Manning with Lai et al., such a combination would not include all the features of claim 2 and would not present a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejection of claim 2 over Lai et al. in view of Manning are respectfully requested.

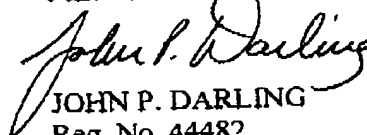
Applicants appreciate the indication that claims 3 and 5-9 define patentable subject matter and that claims 10 and 11 are allowable.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance, and a Notice to that effect is earnestly solicited. Should further issues require resolution prior to allowance, the Examiner is respectfully requested to telephone the undersigned.

The Commissioner is authorized to charge any fees or credit any overpayment applicable to this filing to Deposit Account 03-3975, control number 082118/0274477.

Respectfully submitted,

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